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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,021	02/17/2004	Fermin Marquez Arzate	MX/JFC04-01	9594
7590 05/06/2005 Law Office of Carmen Pili Ekstrom 727 Sunshine Dr Los Altos, CA 94024			EXAMINER MAYO III, WILLIAM H	
			ART UNIT 2831	PAPER NUMBER

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/780,021

Applicant(s)

ARZATE ET AL.

Examiner

William H. Mayo III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in present Application No. 10/780,021, filed on February 17, 2004.

Drawings

2. The drawings are objected to because Figure 3 lacks the proper cross-hatching which indicates the type of materials, which may be in an invention. Specifically, the cross hatching to indicate the conductive and insulation materials is improper. The applicant should refer to MPEP Section 608.02 for the proper cross-hatching of materials. Correction is required.

Specification

3. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

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The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

4. The abstract of the disclosure is objected to because it contains run on sentences, which is improper content for the abstract. The applicant should rewrite the abstract to delete the run on sentences. Correction is required. See MPEP § 608.01(b).

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(f) BRIEF SUMMARY OF THE INVENTION.

(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(h) DETAILED DESCRIPTION OF THE INVENTION.

(i) CLAIM OR CLAIMS (commencing on a separate sheet).

(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Content of Specification

(a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.

(b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.

(c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.

(d) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.

(e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:

- (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

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- (i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (j) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).
- (k) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

5. The disclosure is objected to because of the following informalities: The applicant lacks the proper headings as disclosed above. Specifically, the applicant should insert the proper headings to provide clarity to the specification.

Appropriate correction is required.

Claim Objections

6. Claim 56 is objected to because of the following informalities: It appears that claim 56 was intended to be an independent claims, since the claim recites all of the structure present in claim 33, in which it improperly depends. The attorney should clarify claim 56. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 33-56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 33 recites the limitation "the transmission circuit" in line 7, which is confusing and renders the claim indefinite. It is unclear whether the applicant is referring to the previous mentioned "one or plurality of transmission circuits" or introducing a new main transmission circuit. If the applicant is referring to the previous mentioned term, then he/she should recite the term with consistency. If the applicant is referring to a new main transmission circuit, then he/she should make the term more distinguishable.

10. Claim 37 recites the limitation "the circuit" in line 2, which is confusing and renders the claim indefinite. It is unclear whether the applicant is referring to the previous mentioned "one or plurality of transmission circuits" or introducing a transmission circuit. If the applicant is referring to the previous mentioned term, then he/she should recite the term with consistency. If the applicant is referring to a transmission circuit, then he/she should make the term more distinguishable.

11. Claim 39 recites the limitation "the stranded pair" in line 3. There is insufficient antecedent basis for this limitation in the claim because there has not been any previous reference to a stranded pair in previous lines of the claims.

12. Claim 42 recites the limitation "the circuit" in line 2, which is confusing and renders the claim "one or plurality of transmission circuits" or introducing a transmission circuit. If the applicant is referring to the previous mentioned term, then he/she should recite the term with consistency. If the applicant is referring to a transmission circuit, then he/she should make the term more distinguishable.

13. Claim 52 recites the limitation "the stranded pair" in line 2. There is insufficient antecedent basis for this limitation in the claim because there has not been any previous reference to a stranded pair in previous lines of the claims.

14. Claim 52 recites the limitation "the protective element" in line 4. There is insufficient antecedent basis for this limitation in the claim because there has not been any previous reference to a protective element in previous lines of the claims.

15. Claim 55 recites the limitation "the product" in line 3. There is insufficient antecedent basis for this limitation in the claim because there has not been any previous reference to a product in previous lines of the claims.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

18. Claims 33-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osornio et al (Pat Num 2002/0003047, herein referred to as Osornio) in view of Asai et al (Pat Num 6,103,317, herein referred as Asai). Osornio discloses a telephone lead in cable (Figs 1-3) for voice, data, and video (VVDL) transmission services (abstract). Specifically, with respect to claim 33, Osornio discloses an underground telephone lead-in cable (10, Fig 3) comprising a rectangular outer cover having a geometrical shape comprising thermoplastic material (16, paragraph 12), wherein the cable (10) has equidistantly in inner structure a plurality of transmission circuits (14 and 18 & 11) comprising self-supporting members (18 & 11), which are formed by two conducting elements made of metal (Page 1, paragraph 12, lines 1-4), wherein said members (18 & 11) are respectively arranged at the opposite ends (left and right ends), in parallel, and in turn are diametrically opposed to the main transmission circuit (14), wherein the cable (10) comprises a core (14, i.e. main transmission circuit) formed by a pair of stranded conductors (12 & 19) placed at the center of the rectangular structure outer jacket (16) of the cable (10), wherein said conductors (12 & 19) are respectively insulated by a thermoplastic compound layer (13); and an extruded cover (16) reinforced with

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thermoplastic material forming the lead-in cable (10, Page 1, paragraph 12, lines 5-8).

With respect to claim 34, Osornio discloses that the two self-supporting members (11 & 18), are made of metal (Page 1, paragraph 12, lines 1-4). With respect to claim 35,

Osornio discloses that the two self-supporting members (11 & 18), are covered by polymers (i.e. embedding thermoplastic materials with flame retardant material, Page 2,

paragraph 15). With respect to claim 36, Osornio discloses that the polymers may be polyethylene or polypropylene (Page 1, paragraph 12). With respect to claim 37,

Osornio discloses that the main circuit (14) formed by a stranded pair of balanced circuits (12 & 19) presents a characteristic impedance of 100 ohms (Page 1, paragraph

12, lines 5-8). With respect to claim 39, Osornio discloses that the stranded pair (12 & 19) is covered with an extruded thermoplastic cover (16) that may be flame resistant

reinforced (i.e. embedding thermoplastic materials with flame retardant material, Page 2, paragraph 15). With respect to claim 40, Osornio discloses that the two self-

supporting members (11 & 18) are made of metal (Page 1, paragraph 12, lines 1-4).

With respect to claim 41, Osornio discloses that the two self-supporting members (11 & 18), are made of metal also act as additional circuit with regard to the core (14)

enhancing the transmission of voice signals because between them they constitute a circuit oriented to the transmission of analog signals (Page 1, paragraph 12, lines 1-4).

With respect to claim 42, Osornio discloses that the main circuit (14) of the stranded pair (12 & 19) permits the transmission of digital signal data at speeds of 155 Mbps

(Page 2, paragraph 15, lines 1-3). With respect to claim 43, Osornio discloses that the main circuit (14) of the stranded pair (12 & 19) is stranded with a smooth surface at

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diameters of to 0.5-0.64 mm (Page 2, paragraph 14, lines 5-7). With respect to claim 44, Osornio discloses that cable (10) permits to span distances of up to 150 meters (Page 2, paragraph 15, lines 7-8), wherein the distance between each strand of the conductors (12 & 18) permits to reduce importantly the diaphonic effects caused by the nearness of other element (11 & 18) emitting electromagnetic signals and also reduces the loss of energy to the other circuit (Page 2, paragraph 15, lines 19-28). With respect to claim 45, Osornio discloses that the each one of the conductors (12 & 19) in the main core (14) are insulated with a thermoplastic layer (13). With respect to claim 46, Osornio discloses that the insulation (13) is applied continuously and highly uniform in such a way that the concentricity of the wall of insulating material with regard to the conductor higher than 90% and can be colored for identification purposes (Page 2, paragraph 15, lines 8-12). With respect to claim 47, Osornio discloses a cable (10) further includes a thin thermoplastic sleeve (15) as protecting element against melting heat up to 240°C (Page 1, paragraph 12, 13-15). With respect to claim 49, Osornio discloses that the conductors (12 & 19) of the main core (14) and the self- supporting members (11 & 18) of the metal cables are elements based on copper or alloys submitted to thermal treatments (Page 1, paragraph 14, lines 10-23). With respect to claim 50, Osornio discloses that conductors (11 & 18) are subject to thermal treatments (Page 1, paragraph 14). With respect to claim 51, Osornio discloses that the thermal treatment is between 45-550°C (Page 1, paragraph 14). With respect to claim 52, Osornio discloses a stranded pair (14) is further comprises a thin thermoplastic sleeve (15) comprising a temperature resistant material and applied helicoidally or longitudinally onto the

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protective element (Page 2, paragraph 14). With respect to claim 54, Osornio discloses that the cable (10) comprises conductors (12 & 19) as components of the core (Figs 1-2), wherein the conductors (12 & 19) are in the range of 16-26 AWG (i.e. 24 AWG, Paragraph 15 on page 2). With respect to claim 55, Osornio discloses that the cable (10) further comprises trimmed edges (20) and recesses (at 17) to permit installation of the cable (10, Page 2, paragraph 16). With respect to claim 56, Osornio discloses an underground telephone lead-in cable (10, Fig 3) comprising a rectangular outer cover having a geometrical shape comprising thermoplastic material (16, paragraph 12), wherein the cable (10) has equidistantly in inner structure a plurality of transmission circuits (14 and 18 & 11) comprising self-supporting members (18 & 11), which are formed by two conducting elements made of metal (Page 1, paragraph 12, lines 1-4), wherein said members (18 & 11) are respectively arranged at the opposite ends (left and right ends), in parallel, and in turn are diametrically opposed to the main transmission circuit (14), wherein the cable (10) comprises a core (14, i.e. main transmission circuit) formed by a pair of stranded conductors (12 & 19) placed at the center of the rectangular structure outer jacket (16) of the cable (10), wherein said conductors (12 & 19) are respectively insulated by a thermoplastic compound layer (13); a thin thermoplastic sleeve (15) as protecting element against melting heat up to 240°C (Page 1, paragraph 12, 13-15) and an extruded cover (16) reinforced with thermoplastic material forming the lead-in cable (10, Page 1, paragraph 12, lines 5-8).

However, Osornio doesn't necessarily disclose the cable comprising a swelling layer surrounding said core electrostatically deposited as moisture protection element

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(claims 33 & 56), nor the swelling powder made of conventional poly (sodium acrylate) (claim 38), nor a filler swelling material deposited electrostatically arranged between the area around the thin sleeve and the protective of thermoplastic material forming the body of the lead-in core of the stranded conductors as moisture element (claims 39, 48 & 53).

Asai teaches a water swellable material, which is cost efficient, has good wetting on and adhesion to many surfaces, and may be applied to cable components, such as wires, rods, tubes, and strength members, to provide the cable with water blocking properties (Col 1 & 3, lines 1-13 & 11-29). Specifically, with respect to claims 33 & 56, Asai teaches a water swellable material composition, that may be placed on cable components such as conductive wires and outer coverings or wrappings (Cols 1 & 8, lines 1-10 & 42-50, respectively). With respect to claim 38, Asai teaches a water swellable material composition, which may be poly(sodium acrylate) homopolymer compound (Col 5, lines 9-15 & 26-40) and may be applied through electrostatic means on a cover layer on the stranded pair during the extrusion of the cover layer (Cols 8-9, 61-67 & 1-8, respectively). With respect to claims 39, 48, & 53, Asai teaches water swellable material composition may be a filler swelling material deposited electrostatically arranged between the area around the thin sleeve and the protective of thermoplastic material forming the body of the lead-in core of the stranded conductors as moisture element (material may be placed on cable components such as conductive wires and outer coverings or wrappings; Cols 1 & 8, lines 1-10 & 42-50, respectively).

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With respect to claims 33, 39, 48, 53, & 56, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the telephone lead in cable of Osornio to comprise a poly(sodium acrylate) homopolymer compound water swellable material coated on the electrical components as taught by Asai because Asai teaches that such a material is cost efficient, has good wetting on and adhesion to many surfaces, and may be applied to cable components, such as wires, rods, tubes, and strength members, to provide the cable with water blocking properties (Col 1 & 3, lines 1-13 & 11-29) and since it has been held to be within general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

With respect to claims 39, 48, 53, & 56, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the telephone lead in cable of Osornio to comprise a water swellable material electrostatically coated on the electrical components as taught by Asai because Asai teaches that such a material is cost efficient, has good wetting on and adhesion to many surfaces, and may be applied to cable components, such as wires, rods, tubes, and strength members, to provide the cable with water blocking properties (Col 1 & 3, lines 1-13 & 11-29) and since it has been held that the presence of process limitations in product claims, in which the product doesn't otherwise patentably distinguish over the prior art, cannot impart patentability to that product.

Response to Arguments

19. Applicant's arguments filed March 14, 2005 have been fully considered but they are not persuasive. Specifically, the applicant argues the following:

- A) There is no motivation to combine the teachings of Asai with Osornio to arrive at the present invention and therefore the 35 USC 103(a) rejection is improper.
- B) Asai discloses a multitude of polymers, and one of ordinary skill in the art would know to pick the specific material, poly(sodium acrylate) homopolymer compound out of the multitude of polymers, which are sometimes combined with photoinhibitors, surfactants, blowing agents, organic/inorganic acids, and adhesion promoters.

With respect to argument A, the examiner respectfully traverses. Firstly, the examiner would respectfully state, that the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Osornio discloses a telephone lead in cable (Figs 1-3) for voice, data, and video (VVDL) transmission services (abstract), except the cable comprising a swelling layer surrounding said core electrostatically deposited as moisture protection element made of conventional poly (sodium acrylate) homopolymer compound and it is applied through

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electrostatic means forming a cover layer on the stranded pair during the extrusion of the flame resistant reinforced thermoplastic cover. Clearly, Osornio also teaches that he is concerned with protecting the interior components from exterior elements, such as water, because Osornio states that such exterior elements, such as water cause of the mature aging of the interior components of the cable (Page 2, paragraph 15). Asai teaches a water swellable material, which is cost efficient, has good wetting on and adhesion to many surfaces, and may be applied to cable components, such as wires, rods, tubes, and strength members, to provide the cable with water blocking properties (Col 1 & 3, lines 1-13 & 11-29). Based on the teachings of both Osornio and Asai, there clearly exist a motivation to incorporate the waterproofing filler as taught by Asai into the cable of Osornio because Osornio discloses that he is concerned with premature aging of the cable resulting from the intrusion of water and Asai teaches a filler component that is cost efficient, has good wetting on and adhesion to many surfaces, and may be applied to cable components, such as wires, rods, tubes, and strength members, to provide the cable with water blocking properties (Col 1 & 3, lines 1-13 & 11-29).

Secondly, there exist a reasonable amount of success, since Asai specifies that the filler material may be utilized on interior components such as wires and strength members, both of which exist in the cable of Osornio, of which he is trying to waterproof (see Page 2, paragraph 15). Thirdly, all of the claimed elements are disclosed with the combination of Osornio and Asai. Therefore, a proper prima facie case of obviousness has been established, as all of the components to establish a prima facie case of obviousness, as disclosed by the MPEP are denoted. In light of the above comments,

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the examiner respectfully submits that there does exist a proper motivation for combining the teachings of Osornio and Asai, and that the 35 USC 103(a) rejection is proper.

With respect to argument B, the examiner respectfully traverses. The fact that Asai discloses an abundance of polymers, with additives, doesn't distract from the suggestion to utilize the waterproofing filler material, such as a conventional poly (sodium acrylate) homopolymer compound. Specifically, it is well settled that a selection of some elements from among may indiscriminately, from the prior art, including the selection from a list of thousands, is a matter of obviousness for one of ordinary skill in the art as long as the prior art teaches the suitability of the selections. *In re Susi*, 440 F.2d 442, 445, 169 USPQ 423, 425 (CCPA 1971); *In re Lemin*, 332 F.2d 839, 841, 141 USPQ 814, 815 (CCPA 1964). Specifically, the courts have been consistent that if a species (configuration) is clearly named, the species claimed is anticipated no matter how many other species are additional named. *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App & Inter. 1990)

(The claimed compound was named in a reference which also disclosed 45 other compounds. Specifically, the Board has held that the comprehensiveness of the listing did not negate the fact that the compound claimed was specifically taught. The Board compared the facts to the situation in which the compound was found in the Merck Index, saying that "the tenth edition of the Merck Index lists ten thousand compounds. In our view, each and every one of those compounds is described' as that term is used in 35 U.S.C. § 102(a), in that publication."). *Id.* at 1718. See also *In re Sivaramakrishnan*, 673 F.2d 1383, 213 USPQ 441 (CCPA 1982) (The claims were directed to polycarbonate containing cadmium laurate as an additive. The court upheld the Board's finding that a reference specifically naming cadmium laurate as an additive amongst a list of many suitable salts in polycarbonate resin anticipated the claims.

The applicant had argued that cadmium laurate was only disclosed as representative of the salts and was expected to have the same properties as the other salts listed while, as shown in the application, cadmium laurate had unexpected properties. The court held that it did not matter that the salt was not disclosed as being preferred, the reference still anticipated the claims and because the claim was anticipated, the unexpected properties were immaterial.)

Therefore, it is axiomatic that it is not necessary for a finding of obviousness under 35 USC 103(a) that all of the elements or teachings of one reference be fully combined with those of another reference. In re Griver, 354 F.2d 377, 381, 148 USPQ 197, 200 (CCPA 1966); In re Billingsley, F.2d 689, USPQ 370, (CCPA 1960). Rather, the proper inquiry under 35 USC 103 is what the references, taken collectively, would have suggested to one of ordinary skill in the art. In re Keller, 642 F.2d 413, 426, 208 USPQ 871, 882 (CCPA 1981). As detailed above, Osornio discloses a telephone lead in cable (Figs 1-3) for voice, data, and video (VVDL) transmission services (abstract), except the cable comprising a swelling layer surrounding said core electrostatically deposited as moisture protection element made of conventional poly (sodium acrylate) homopolymer compound and it is applied through electrostatic means forming a cover layer on the stranded pair during the extrusion of the flame resistant reinforced thermoplastic cover. Clearly, Osornio also teaches that he is concerned with protecting the interior components from exterior elements, such as water, because Osornio states that such exterior elements, such as water cause of the mature aging of the interior components of the cable (Page 2, paragraph 15). Asai teaches a water swellable material, which is cost efficient, has good wetting on and adhesion to many surfaces, and may be applied to cable components, such as wires, rods, tubes, and strength

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members, to provide the cable with water blocking properties (Col 1 & 3, lines 1-13 & 11-29). Based on the teachings of both Osornio and Asai, there clearly exist a motivation to incorporate the waterproofing filler as taught by Asai into the cable of Osornio because Osornio discloses that he is concerned with premature aging of the cable resulting from the intrusion of water and Asai teaches a filler component that is cost efficient, has good wetting on and adhesion to many surfaces, and may be applied to cable components, such as wires, rods, tubes, and strength members, to provide the cable with water blocking properties (Col 1 & 3, lines 1-13 & 11-29). In light of the above comments, it is submitted that the 35 USC 103(a) is proper and just.

Conclusion

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Communication

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Mayo III whose telephone number is (571)-272-1978. The examiner can normally be reached on M-F 8:30am-6:00 pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (571) 272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William H. Mayo III
Primary Examiner
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WHM III

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April 25, 2005